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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,785	05/18/2001	Walter Gerard Antognini	3379/3	9429
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BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP 900 THIRD AVENUE NEW YORK, NY 10022				
			EXAMINER COLBERT, ELLA	
			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,785

Applicant(s)

ANTOGNINI ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-4 are pending. This Application is a continuation of 08/977,510 filed 11/24/97 now abandoned which is a CIP of 08/609,549 filed 03/01/96 now patent no. 6,176,427.

2. The IDS filed 03/06/02 has the following references missing: 4-318668 Japan (11/1992); and Paulidas, Swartz & Yang, Xerox, and Infolmaging non-patent articles.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ at 193, 197 (1980).

4. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the claimed subject matter is directed to a "practical application"; or
(2) whether the invention produces "a useful, concrete and tangible result.", that is, whether the claimed subject matter is applied in a practical manner to produce a useful result. "[C]ertain types of mathematical subject matter, standing alone, represent nothing more than abstract ideas until reduced to some type of practical application, i.e., 'a useful, concrete and tangible result.' (*State Street*, 149 F.3d 1373, 47 USPQd at 1600-01 (citing *Alppat*, 33 F.3d 1544, 31 USPQ2d at 1557)).

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract ideas, law of nature, natural

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phenomena) that do not apply, involve, use, or advance technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

(A) In the present case, claims 1 and 2 recite an abstract idea only. The recited method and steps of the claim merely, a) accessing information, selecting information, selecting a means for sending the bill, preparing the bill, sending the bill; and b) selecting a means for sending the payment, selecting a person to receive the payment, preparing a payment, sending the bill prepared consistent with the means do not apply, involve, use, or advance the technological arts since all of the recited method and means steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to select, prepare, send, and pay a bill. The claims do not have a computer performing the method in the preamble or a user accessing information at the computer or selecting at the computer a means for payment.

(b) Independent claims 3 and 4 further define a bill that contains in digital form information and a bill payment instrument, which only constitute ideas that can be performed mentally or by pencil and paper, therefore still do not represent a practical application of the idea to advance the technology art. The bill containing in digital form information and a bill payment instrument in digital form, therefore still do not represent a practical application of the idea to advance the technology art. The bill containing in

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digital form sufficient information and a bill payment instrument are not sufficient to present a practical application of the idea to advance the technological arts. Claims 3 and 4 do not claim the digital form as being embodied in a computer readable medium. Independent claims 3 and 4 are therefor rejected.

In addition, for a claimed invention to be statutory, it must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a method for presenting and paying a bill (i.e., repeatable) used in accessing the information, preparing the bill, sending the bill, and paying the bill (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-4 are deemed to be directed to non-statutory subject matter.

With respect to the rejection under 35 U.S.C § 101, the Examiner asserts that the claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The method of claims 1 and 2 being performed on a computer and 3 and 4 as independent claims not claiming a method for a bill with steps

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that follow and the digital form being embodied in a computer readable medium are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claims 3 and 4 should have been dependent claims depending from claim 2 or had steps that follow if they are independent claims.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites "... consists of digital data sufficient to pay". Do Applicants' mean "... consists of digital data sufficient to pay the bill"? Claim 2 recites "... the means selected for paying,". Do Applicants' mean "... the means selected for paying the bill,"? These claim limitations are unclear. Claim 3 recites "... contains in digital form sufficient information to pay the bill." Do Applicants' mean "A computer implemented method comprising the steps of: a bill in digital form that contains sufficient information in digital form to pay the bill; (the next steps, etc)" or "The method of claim 2, further comprising the step of payment for a bill containing in digital form sufficient information to pay the bill"? Claim 4 reciting "...digital form sufficient information to pay a bill". Do Applicants' mean "A computer implemented method comprising the steps of: using a bill payment instrument which contains in digital form sufficient information to pay a bill; (the next steps, etc.)" or "The method of

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claim 2, further comprising the step of using a bill payment instrument which contains in digital form sufficient information to pay a bill”?

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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12. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,465,206) Hilt et al, hereinafter Hilt in view of (US 5,649,117) Landry further in view of (US 5,677,955) Doggett et al, hereinafter Doggett.

With respect to claim 1, Hilt teaches, A method of bill presentment comprising the steps of: accessing information concerning the bill (col. 3, lines 43-56) and selecting information to include in the bill where at least one available choice in the selection consists of digital data sufficient to pay the bill, and where at least some of the information selected consists of information accessed (col. 3, lines 56-67, col. 4, lines 1-6 and lines 30-67, and col. 5, line 1); and preparing the bill in accordance with the information selected to be included (col. 5, lines 38-51).

Hilt fails to teach, selecting at least one means for sending the bill. However, Landry teaches, selecting at least one means for sending the bill (col. 6, lines 32-63). Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Hilt because anyone familiar with two or more such means for sending a bill would, select a particular means for sending the bill whether it is by computer or by mail through the postal service.

Hilt and Landry fail to teach, preparing the bill in accordance with the information selected to be included and sending the bill in accordance with the at least one means selected for sending the bill.

Doggett teaches, preparing the bill in accordance with the information selected to be included (col. 1, lines 44-52) and sending the bill in accordance with the at least one means selected for sending the bill (col. 2, lines 60-67). Hence, it would have been

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obvious to one having ordinary skill in the art at the time the invention was made to prepare the bill according to the information to be included and send the bill according to a least one means selected for sending the bill and to modify in Hilt because such a modification would allow Hilt to have the body of the payment instrument (check) instruct the payer's bank to pay the stated sum of money to the payee and the check identify the payer's bank, the payer's account number (using magnetically readable characters) at the payer's bank, and the payer (usually by printed name and address) and to have the payer sign the check with the check containing a routing and transit number indicating the routing of the check to the payer's bank for presentment.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2– 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,677,955) Doggett et al, hereinafter Doggett in view of (US 5,649,117) Landry .

With respect to claim 2, Doggett teaches, A method of payment comprising the steps of: selecting a means for payment where at least one available choice consists of digital data sufficient to pay (col. 3, lines 1-41); selecting a person to receive the payment (col. 9, lines 48-67, col. 10, lines 1-4, and figure 5); preparing the payment in accordance with the means selected for paying (col. 9, lines 48-67 and col. 10, lines 1-

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29);and sending the bill so prepared consistent with the means selected for sending the bill to the person selected to receive the bill (col. 12, lines 33-53).

Doggett fails to teach, selecting a means for sending the payment.

Landry teaches, selecting a means for sending the payment (col. 1, lines 30-45- there are a number of means of making payments). Hence, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a means for sending the payment and to modify in Doggett because such a modification would allow Doggett to have more than one means for sending the payment for the bill. The payment can be sent in written form through the postal service or if a check is deposited with the postal service it is delivered to a payee who relays it to a bank and banking system collects the payment. The simplest form of bill payment consists of the payor personally presenting cash to the payee.

With respect to claim 3, Doggett teaches, A bill that contains in digital form sufficient information to pay the bill (col. 3, lines 1-11).

With respect to claim 4, Doggett teaches, A bill payment instrument which contains in digital form sufficient information to pay a bill (col. 3, lines 12-50).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

Pickering (US 5,483,445) disclosed automated bill consolidation.

Deming (US 4,823,264) disclosed an electronic funds transfer system.


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Inquiries

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


E. Colbert
November 15, 2003